

REMARKS

Applicants submit the present *Response to Final Office Action* in order to respond to the positions and arguments presented in the Final Action mailed August 9, 2007. For the reasons discussed below, Applicants respectfully submit that *prima facie* rejections have not been made against the pending claims. Accordingly, Applicants request withdrawal of the pending rejections and either allowance of the pending claims or issuance of a non-final Office Action in the event that any new grounds for rejection are presented.

I. **The Final Action Does Not Set Forth Proper Rejections For Claims 5, 7, 9, 17-25, 29-31 and 35-36**

As an initial matter, the **Final Action fails to set forth proper rejections for 17 of the 35 pending claims**. In particular, Claims 17-18, 22, 24-25, 30-31 and 36 each stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application No. 2002/0173277 to **Takao** et al. ("Takao") in view of U.S. Patent Application No. 2002/0025810 to **Takayama** et al. ("Takayama"). Claims 19-21, 23, 29 and 35 stand rejected under 35 U.S.C. § 103(a) as being obvious over Takao in view of Takayama and one of several secondary references. Each of Claims 17-25, 29-31 and 35-36 depend from one of independent Claims 14, 26 or 33. Notably, **none of independent Claims 14, 26 or 33 stand rejected as being obvious over the combination of Takao and Takayama**. As such, the Final Action fails to set forth a *prima facie* rejection of Claims 17-25, 29-31 and 35-36, as the Final Action fails to identify where all of the recitations of these claims are found in the cited combination of references.

Similarly, Claims 5, 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Takao in view of U.S. Patent Application No. 2002/0173277 to Tzamaloukas et al. ("Tzamaloukas"). Claims 5, 7 and 9 each depend from independent Claim 1. While independent Claim 1 has been rejected as being obvious over the combination of Takao and Takayama, Claim 1 has **not** been rejected as obvious over the combination of Takao and Tzamaloukas. As such, the Final Action also fails to set forth a *prima facie* rejection of Claims 5, 7 and 9, as the Final Action fails to identify where all of the recitations of these claims are found in the combination of Takao and Tzamaloukas.

Applicants note that the above-discussed problem with the rejections of Claims 5, 7, 9, 17-25, 29-31 and 35-36 was discussed in detail in Applicants' Amendment of May 7, 2007. (May 7, 2007 Amendment at 9, 12 and 15). The Final Action, however, never acknowledged Applicants' argument regarding the improper nature of the rejections, nor did the Final Action set forth new grounds of rejection with respect to these claims. While it may have been the Examiner's intention to reject some or all of Claims 5, 7, 9, 17-25, 29-31 and 35-36 based on different combinations of references, no such rejections have yet been presented. It is the burden of the Patent Office to set forth proper rejections for each claim to thereby afford the Applicants a full and fair opportunity to respond to and/or argue against the rejections as appropriate. Such proper rejections have not been asserted here, and hence the rejections of Claims 5, 7, 9, 17-25, 29-31 and 35-36 should clearly be withdrawn. Moreover, if a new Office Action is issued in order to provide proper rejections of the above claims that explain where each recitation of the claims is allegedly found in the cited art, Applicants respectfully submit that any such Office Action should be a non-final Office Action so that Applicants have a full and fair opportunity to respond to any such new rejections.

II. The Final Action Does Not Set Forth A Proper Rejection of Claim 1

Independent Claim 1 also stands rejected as being obvious over the combination of Takao and Takayama. As discussed in more detail in Applicants' May 7, 2007 Amendment, the "mode switcher" of Takao that is identified as comprising the "at least one control unit" of Claim 1 includes switching controllers 53 and 34 and a signal processing unit 50 that are part of the base station, and are not part of the mobile terminal. (*See* May 7, 2007 Amendment at 10-11; *see also* Takao at Fig. 10 and ¶ 0067, stating that the "switching controllers 53 and 34, and the signal processing unit 50 constitute a mode switcher."). As such, the "mode switcher" of Takao cannot comprise the "at least one control unit" of the "wireless terminal" of Claim 1 as two of the three components that constitute the "mode switcher are **not** part of the mobile station of Takao, but instead are part of the base station of Takao. As Applicants further pointed out in their Amendment of May 7, 2007, what Claim 1 recites is that the at least one control unit is (1) "responsive to the data processor" and (2) "controls communications with an access point." (*See* May 7, 2007 Amendment at 10-11). However, the mode switcher of Takao clearly is not responsive to a data processor that is part of a

wireless terminal, nor does the mode switcher of Takao control communications with an access point.

In response to these arguments, the Final Action states that Takao discloses at Fig. 6 a mobile station that includes a switching controller and a signal processing unit. (Final Action at 2). However, **Fig. 6** of Takao depicts the structure of **a prior art wireless terminal**, whereas the rejection of the pending claims is based on **Fig. 10** of Takao, which discloses **an embodiment of a wireless terminal according to the invention of Takao**. As such, the Final Action is **improperly using the invention of Claim 1 as a road map to take bits of pieces of multiple embodiments of Takao in an effort to replicate the invention of Claim 1**. The Final Action provides no explanation as to why one of skill in the art would attempt to combine the **prior art** cited in Takao with the invention of Takao, and Applicants respectfully submit that no such motivation in fact exists as Takao explains in detail the various **problems** with the prior art embodiment of Fig. 6. (See, e.g., Takao at ¶¶ 0023-0027). Accordingly, Applicants respectfully submit that the Response to Arguments section of the Final Action merely serves to confirm Applicants showing that Claim 1 is patentable over the cited art. Thus, the rejection of Claim 1, and the claims depending therefrom, should be withdrawn.

III. The Final Action Fails to Address Applicants' Showing that Claims 3, 5, 13, 15, 17, 24 and 36 are Independently Patentable Over the Cited Art

Applicants' May 7, 2007 Amendment also included showings as to why dependent Claims 3, 5, 13, 15, 17, 24 and 36 are independently patentable over the cited art. (May 7, 2007 Amendment at 9, 11-12 and 15). In fact, with respect to Claims 13, 15, 17, 24 and 36, neither the first Office Action nor the Final Action includes any showing as to where the specific recitations of these claims can allegedly be found in the cited art. The Response to Arguments section of the Final Action, however, did not respond to Applicants' showing, nor does the Final Action even attempt to identify where the recitations of these claims can allegedly be found in the cited art. Applicants therefore respectfully submit that the rejections of Claims 3, 5, 13, 15, 17, 24 and 36 should be withdrawn for this additional reason. Moreover, if a new Office Action is issued in order to provide a proper rejections of the above claims that explain where each recitation of the claims is allegedly found in the

cited art, Applicants respectfully submit that any such Office Action should be a non-final Office Action so that Applicants have a full and fair opportunity to respond to any such new rejections.

IV. The Final Action Does Not Rebut Applicants' Showing that Claim 9 is Independently Patentable Over the Cited Art

Applicants also showed in their May 7, 2007 Amendment that the Examiner had failed to show where the cited references taught that "data associated with a first application running on the wireless terminal is transmitted to the wireless terminal over the first communications channel, and wherein at least some of the control signals associated with the first application are transmitted from the wireless terminal to the access point over the second communications channel" as is recited in Claim 9. The Response to Arguments section of the Final Action argues that paragraphs 5, 22 and 29-30 of Takao discloses the recitation of Claim 9. (Final Action at 3). Applicants respectfully submit, however, that the cited portions of Takao do not disclose transmitting data associated with a first application over a first communications channel, while transmitting control signals associated with that application over the second communications channel. Accordingly, the rejection of Claim 9 should be withdrawn for this additional reason.

V. The Rejections of Independent Claims 14 and 26

Applicants also explained in their May 7, 2007 Amendment why independent Claims 14 and 26 are patentable over the cited art. The Response to Arguments section of the Final Action did not even attempt to respond to Applicants' showing as to the patentability of Claims 14 and 26. Applicants therefore respectfully request that the Examiner either rebut Applicants' showing, or withdraw the rejections of Claims 14 and 26, as well as the rejections of each of the claims depending therefrom.

VI. Conclusion

For each of the above, reasons, Applicants respectfully submit that the Final Action was prematurely issued in the present case, and that the Examiner has failed to make a *prima facie* showing of unpatentability with respect to the pending claims. Accordingly, Applicants

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Filed: March 23, 2004
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respectfully request allowance of the claims and passing of the application to issue in due course. Alternatively, to the extent that a new Office Action is issued that attempts to overcome the above-noted deficiencies with the Final Action, Applicants respectfully submit that any such Office Action should be a non-final Office Action so that Applicants have a full and fair opportunity to respond to the new/revised rejections contained therein.

Respectfully submitted,




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